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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,957	11/15/2001	Edward Clarke	YOR920010760US1	6656

7590 06/27/2005

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EXAMINER

ZHEN, WEI Y

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/003,957

**Applicant(s)**

CLARKE ET AL.

**Examiner**

Wei Y. Zhen

**Art Unit**

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2191

1. This office action is in response to the amendment filed on 4/15/2005.
2. Claims 1-19 are pending.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16, 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 16, the claim recites a method claim for dynamic content resolution comprising various steps. These steps are something that can be done by a person as a mental step or using pencil and paper. Therefore, the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

As per claim 18, the claim recites a computer program product having computer program which is program per se and is non-statutory as not being tangibly embodied in a manner so as to be executable.

4. Claims 1-9 and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Date et al., CCA Guide to SQL/DS" Addison Wesley Publishing company", 1989 (hereinafter Date).

See the previous office action for the rejection to these claims.

Art Unit: 2191

5. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Date in view of Wanger, US Patent No. 5,742,845.

See the previous office action for the rejections to claim 10.

Claim 19 is rejected for the reason set forth in the rejections of claims 1, 2 and 10 (see the previous office action for the rejections to claims 1, 2 and 10).

### *Response to Arguments*

6. Applicant's arguments filed 4/15/2005 and 3/29/2005 have been fully considered but they are not persuasive.

Applicant's argument:

1) Date's INSERT statement does not include state statements. "WHERE NOT" statement is the logical condition statement and the "WHERE SP.. ." statement is the logical parameter. There is no state statements.

Examiner's response:

1) In the previous office action, the Examiner points out that one or more insert statements (E.g. see page 134, lines 35-39 and 40-46) inserted into the source program file, the insert statement having one or more logical condition statements (E.g. see page 134, lines 39 and 44-47, "WHERE . . .") with one or more logical parameters (E.g. see page 134, lines 39, S.S# and SP.S# ) and *one or more state statements (E.g. see page 134, lines 36-38, "INTO OJEX. . .")*.

Applicant fails to point out the error of the rejection of "*one or more state statements (E.g. see page 134, lines 36-38, "INTO OJEX. . .")*". Therefore, the rejection is maintained.

Applicant's argument:

Art Unit: 2191

2) Date's INSERT statement is merely a retrieval statement. This INSERT statement is not designed for dynamic integration of content and form. There is no indication that Date's INSERT statement maintains control over the placement decision of form and content in a unified presentation while allowing separate requirements on content and form to drive that decision.

Examiner's response:

2) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., INSERT statement maintains control over the placement decision of form and content in a unified presentation while allowing separate requirements on content and form to drive that decision) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argument:

3) Date also does not show an insert parser. The parser of Date does not parse selected state statement into one or more content source indicators.

Examiner's response:

3) In the previous office action, the Examiner points out that the parser (E.g. see page 27, lines 6-13 and page 28, Fig. 2.3 Preprocessor and associated text)...*parses the selected state statement into one or more content source indicators (E.g. see page 134, lines 28-47, Table OJEX)*". Applicant fails to point out the error of the rejection of "*parses the selected state*

Art Unit: 2191

*statement into one or more content source indicators (E.g. see page 134, lines 28-47, Table OJEX")". Therefore, the rejection is maintained.*

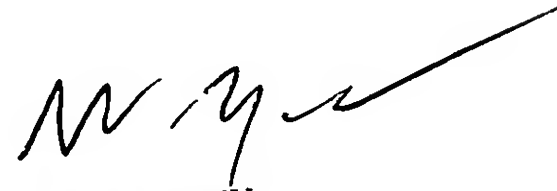
### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei Y. Zhen whose telephone number is (571) 272-3708. The examiner can normally be reached on Monday-Friday, 8 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wei Zhen  
6/22/2005

  
WEI Y. ZHEN  
PRIMARY EXAMINER